

Attorney Docket No. 394-137

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Craig Novak et al.

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Art Unit 3632

Serial No.: 09/909,423

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Examiner: Sterling, Amy Jo

For: Decorative Gift Bag Balloon Holder

Filed: July 19, 2001

March 30, 2004

BRIEF ON APPEAL

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Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This brief is being submitted in triplicate to The Board of Patent Appeals and Interferences in support of the appeal in the above-captioned matter. This appeal is from the final decision of the Examiner dated October 30, 2003 finally rejecting claims 17, 18 and 20. Applicant appeals the rejection of claims 17, 18 and 20 in the.

1. Real party In Interest

The application has been assigned to the real party in interest, Unique Industries, Inc. of 2400 S. Weccacoe Avenue, Philadelphia, Pennsylvania 19148.

2. Related Appeals and Interferences

No cases are known which will directly affect or be directly affected by or have a

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2. Related Appeals and Interferences

No cases are known which will directly affect or be directly affected by or have a

bearing on any decision by the Board in this appeal.

3. Status of Claims

The application presently contains claims 1 through 3, 8, 9, 14 and 17-24. Claims 17, 18 and 20 had been subject to a final rejection in the action of October 30, 2003 and are involved in this appeal.

Claims 1 through 3, 8, 9 and 14 have been allowed, and claims 19 and 22 through 24 have been objected to for depending from rejected claims.

Claims 4 through 7, 10 through 13, 15, 16 and 21 have been cancelled.

4. Status Of Amendments

No amendments are pending.

5. Summary Of Invention

The present invention relates to a decorative balloon holder for securing one or more buoyant balloons in position on a tabletop or the like during festive occasions. Various devices for holding a buoyant party balloon in a desired position on a tabletop have been proposed, but such products are often not very attractive for use at a festive occasion such as a birthday party, or are relatively expensive to manufacture.

As acknowledged by applicants in the specification (see, page 3, lines 4-10 in the specification as filed), balloon holders formed of a small gift bag having a weight such as small lead fishing weights or sand placed in the bottom of the gift bag had been used with decorative tissue paper placed loosely inside to cover the weight. Such balloon holders

simulating a gift bag are festive and very desirable for many party occasions where buoyant balloons need to be held in place on a tabletop or the like.

However, such balloon holders simulating a gift bag are typically made individually as craft items, and are not manufactured readily by automatic techniques. Further, such craft item balloon holders are difficult to ship, or to store or display effectively in a retail environment and have not, therefore, become commercial items that can be mass distributed.

By the present invention, the applicants provided a decorative balloon holder that may simulate a gift bag and yet can be manufactured, stored, shipped and displayed at retail in a manner preserving the decorative appeal of the balloon holder.

Fig. 1 of the application illustrates a party balloon 10 having a string 12 tied to handles 14 of a decorative gift bag 16 forming part of a balloon holder 18 of the first embodiment of the present invention. The balloon holder 18 illustrated in Fig. 1 as resting on a tabletop 20 and has sufficient weight to counteract the buoyancy of one or more balloons 10.

As shown in Fig. 2 of the application, a core 22 formed of an inexpensive but weighty material such as compressed sand held by an adhesive; or a sand, cement and water mixture, is formed into a shape corresponding to the interior of the gift bag. Decorative material is provided to extend outwardly from the open top of the gift bag 16, and the decorative material is formed from a length 24 of decorative sheet material having its upper portion 28 cut into a series of strips 30.

The lower portion 32 of the decorative material is held around the periphery of the core 22 by orthogonal strips of tape 34 and 36. In this way, the decorative material is held to the core 22 around its generally rectangular periphery to conceal the inner core 22 from casual view by forming a decorative effect about the rectangular opening in the top of the gift bag 16 when the strips 30 are arranged to extend outwardly from the open gift bag 16.

The core 22 is preferably adhered to the bottom 38 of the gift bag 38 by an adhesive, tape or the like to secure the assembly together, and the upper portions of the handles 14 are preferably secured together by adhesive, tape, fine line or the like. By holding the decorative material to the core 22, as well as by securing the upper portions of the handles together, the assembled balloon weight will be held together during shipment, storage or handling. A decorative balloon holder simulating a gift bag is thus suitable to be shipped securely, and handled at retail while maintaining its attractiveness to the consumer.

Fig. 3 illustrates a second embodiment of the present invention having a larger gift bag 40. As shown in Fig. 4, an inner liner 41 conforming generally to the shape of the interior of the gift bag 40 is fitted within the gift bag 40. The inner liner may be formed of cardstock and is folded into shape and secured by tape 41a.

The core 42 of the second embodiment is preferably wrapped in protective paper 43 secured by tape 44, and the core 42 is held to the interior of the lower portion 46 of the inner liner 41 by one or more strips of tape 48 engaging the bottom of the wrapped core 42 and the sides of the inner liner 41. The decorative material 50 formed in a manner similar to the

decorative material 30 of the first embodiment is held to the interior of the upper periphery 52 of the inner liner 41.

By use of the inner liner 41, a balloon weight formed of a larger size gift bag will have support to maintain its decorative shape and assemblage during handling and shipment. As in the first embodiment, the upper portions of the handles 14 may be secured together by adhesive, tape, fine line or the like to complete the assemblage.

6. Issues

A. Whether the Examiner properly followed the relevant law in rejecting the claim 20 under 35 U.S.C. § 102 without considering express recitations in the claim.

B. Whether the Examiner properly rejected claims 18 and 20 under 35 U.S.C. § 103 by modifying the non-analogous art of the Valentino patent.

C. Whether the Examiner properly rejected claims 18 and 20 under 35 U.S.C. § 103 by modifying the Valentino patent with features from other references without any motivation from the references for the modification of Valentino.

7. Grouping of Claims

The rejection of claims 17, 18 and 20 do not stand or fall with the rejection of any single claim. The claims are rejected under differing application of the references. .

8. Argument

A. The rejection of claim 17 through under § 102 in view of the Valentino patent

Claim 17 defines the core as part of a “means” clause, and the core is defined as a

“weighty mass of dense material provided with sufficient weight for holding a plurality of buoyant party balloons in place... .” Further, the decorative material secured within the decorative bag in a position to conceal the core from casual view is defined as extending outwardly from the bag as the balloon holder is displayed for retail sale. This positioning of the decorative material for display at retail sale forms part of a “means” clause, and thus the claim includes an express limitation that decorative material provides decorative appeal for the balloon holder at retail display.

Valentino describes an insert for a decorative gift bag comprised of a platform 16 carrying a plurality of lengths 18 of tissue paper fan-folded to provide individual segments lying atop one another. See, col. 2, lines 42-48. The platform of the Valentino patent is described as similar to the cardboard backings often inserted in the bottoms of gift bags, and certainly is not described as a weighty mass of dense material, and certainly is not “provided,” i.e., designed or engineered, to have sufficient weight to hold a plurality of party balloons, nor is the cardboard platform of the Valentino patent described as having sufficient weight to hold a plurality of party balloons.

The Examiner held terms such as “dense” or the weight of buoyant balloons are relative, and suggested air could be considered a dense mass or a cardboard core may be weighty enough to hold one or two balloons. The Examiner also stated a “cardboard may be weighty enough to hold one or two large balloons or several smaller balloons, depending on the size and density of the cardboard and the size and density of the gas which inflates the

balloon.”

However, claim 20 requires “party balloons” and the Valentino reference refers to cardboard backings of the type inserted into gift bags. Note just any size cardboard and balloons are described in the reference or recited in the claim. Moreover, as noted in M.P.E.P. 2111.01, “means” clauses in a claim should be interpreted as ascribed in the specification, and assuredly the specification precludes a weighty mass of dense material provided with sufficient weight for holding a plurality of buoyant party balloons in place would not include a cardboard insert. Party balloons are a well understood commodity and nothing in the Valentino patent suggests the cardboard platform of the type typically inserted into the bottom of a gift bag will hold down a plurality of party balloons.

Further, the Valentino patent does not describe any decorative material secured within the decorative bag in a position to conceal the platform from casual view *and* that extends outwardly from the bag as the balloon holder is displayed for retail sale to provide decorative appeal for the balloon holder at retail display.

The decorative material of the Valentino patent extends outwardly from the bag *after* a retail sale has been made to conceal the purchase within the bag. See col. 2, lines 62-65 explaining the decorative material is pulled from the bag to enhance the packaging of a gift purchased to be inserted in the bag.

The Examiner has held the above recitation to be one of intended use, and inherent from the disclosures of Valentino. However, Figs. 3 and 4 of the Valentino patent do not

illustrate the decorative material concealing the core from casual view, and Figs. 5-9 surely illustrate the positioning of the decorative material *after* a retail sale has been made of a product to be placed in the bag. There is nothing inherent in the description of Valentino of a decorative material being used to conceal a core of weighty material within the bag while the bag is displayed for retail sale. When the bag is displayed prior to retail sale, the decorative material is fan-folded in place on the platform; not positioned to conceal it.

The Examiner may not ignore these recitations of the claim in applying Valentino under § 102 .

B. The rejection of claims 18 and 20 under § 103

Claim 18 has been rejected under the Valentino patent in view of the Mahoney teaching securing a card board insert to a the bottom of a gift bag, and claim 20 by the Metz patent. As noted in M.P.E.P. § 2141.01(a), a reference applied under § 103 must be from an analogous art. In order to rely on a reference as a basis for rejection under § 103, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 230 U.S.P.O. 313 (Fed. Cir. 1986); *In re Clay*, 23 U.S.P.Q.2d 1058,1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and *Wang*

Laboratories Inc. V. Toshiba Corp., 26 U.S.P.Q.2d 1767 (Fed. Cir. 1993).

It is submitted that the Examiner may not properly reject claims to a decorative balloon holder under § 103 in view of the Valentino patent describing a gift bag designed to hold purchases made in a store. The rejections of claim 18 and 20 are based on a modification of non-analogous art and are, therefore, improper.

Valentino, of course, does not teach holding any party balloons, and one would have no motivation to substitute a trapezoidal weight as a balloon holder for the cardboard insert holding the fan-folded lengths 18 of paper of Valentino, as recited in claim 20.

The Examiner has not suggested any motivation or suggestion *from the references* to substitute a trapezoidal weight as a balloon holder for the cardboard insert of Valentino.

The Examiner has stated a motivation to change the shape of the core "is found in adding more weight to the core in order to hold the decorative bag in the desired location while subjecting it to an outside force."

Such "motivation" comes from the Examiner's desire to pick and chose isolated features to combine to meet applicants' claim language, not a teaching from the references. The Examiner is reconstructing claim 20 from isolated elements of the prior art with the only teaching to do so being applicant's disclosure. Such hindsight reconstruction of the claimed invention is improper. The rejection of claim 1 and the claims depending therefrom is improper under the guidelines of M.P.E.P §2143.01.

The Examiner must apply teachings from *the references* to substitute a trapezoidal

weight as a balloon holder for the cardboard insert of the Valentino patent. Combining elements of the art to produce the claimed invention is proper only where there is some teaching, suggestion, or motivation to do so found either in the references themselves, or in the knowledge generally available in the art. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

The Examiner has relied on impermissible hindsight in making the rejection based upon obviousness. "It is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps". *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The Examiner has combined isolated features from the references to reconstruct what he interprets as applicant's claimed invention with the motivation for the combination being applicant's own disclosure or claim language. Such actions by the Examiner violate the strictures of *In re Fritch* in reconstructing the claimed invention by selecting bits and pieces from the prior art by using applicant's disclosure as a guide.

The law is clear that the mere fact that the references can be combined to meet the invention claimed does not render the resultant combination obvious under the Statute unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir 1990). The fact the aspects of the invention may be individually known in the art does not make their combination obvious under the Statute without some

reason from the art for the combination of elements proposed by the Examiner. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (PTO Bd. Pat. App. & Inter. 1993). It is also improper to rely upon the level of skill in the art to provide the suggestion to combine features of different references. *Al-Site Corp. v. VSI Intl. Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Applicant has provided a device which solves the problem of providing a commercially viable decorative balloon holder that may simulate a gift bag and yet can be manufactured, stored, shipped and displayed at retail in a manner preserving the decorative appeal of the balloon holder. Although the solution of applicant's invention may appear simple in hindsight, such simplicity is no basis for rejection. *In re Horn, Horn, Horn and Horn*, 203 U.S.P.Q. 969 (CCPA 1979) and cases cited at page 971.

It is also respectfully submitted that the Examiner is required to consider the invention "as a whole" in evaluating patentability under 35 U.S.C. § 103. *Hodosh v. Block Drug Co. Inc.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187, n.5 (Fed. Cir.1986). As noted in *In re Sponnobile*, 405 F.2d 578, 585, 160 U.S.P.Q. 237 (CCPA 1969):

A patentable invention, within the ambit of 35 U.S.C. § 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. Although we believe that appellant, here, has actually done more than this in making his combination, we also believe that a more proper, albeit not exclusive, inquiry in a case such as this is to

look further as to the reasons for making the combination.

It should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103. In re Antonson, 272 F.2d 948, 47 CCPA 740; In re Linnert, 309 F.2d 498, 50 CCPA 753. The court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings. In re Murray, 268 F.2d 226, 46 CCPA 905; In re Sporck, 301 F.2d 686, 49 CCPA 1039. *The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious.* In re Leonor, 395 F.2d 801, 55 CCPA 1198. 405 F.2d at 832-33. (Emphasis added).

The Examiner stated a motivation to change the shape of the core "is found in adding more weight to the core in order to hold the decorative bag in the desired location while subjecting it to an outside force," but did not find any such motivation from the references.

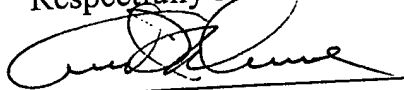
The Examiner has not suggested any motivation or suggestion *from the references* to substitute a core of trapezoidal shape for the cardboard platform of the Valentino patent.

What teachings are found *in the references* for taking the flat cardboard platform of

the Valentino patent and substitute a core of trapezoidal shape?

It is, therefore, request the Board reverse the rejections made by the Examiner.

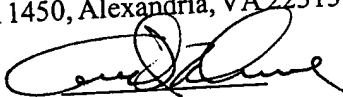
Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: : Mail Stop- Appeal Brief- Patents, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 30, 2004.

March 30, 2004



Gerard F. Dunne

APPENDIX-CLAIMS ON APPEAL

The claims on appeal are:

17. A balloon holder, comprising a decorative bag, means including a core formed of a weighty mass of dense material provided with sufficient weight for holding a plurality of buoyant party balloons in place, said core being positioned within said decorative bag, and means including decorative material secured within said bag in a position to conceal said core from casual view and extending outwardly from said bag as the balloon holder is displayed for retail sale for providing decorative appeal for the balloon holder at retail display.

18. A balloon holder as set forth in claim 17, said core being secured to the interior of said decorative bag.

20. A balloon holder, comprising a decorative bag, a core formed of a weighty material adapted to hold one or more buoyant balloons in place and secured to the interior of said decorative bag, said decorative bag concealing said core from casual view, said core having sidewalls generally trapezoidal in shape to taper towards the upper portion of said decorative bag.